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3625

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

T. ONO et al

Serial No. 08/979,810

Group Art Unit: 2165

Filed: November 25, 1997

Examiner: F. Thompson, Jr.

For: ELECTRONIC COMMERCE SUPPORT
METHOD AND APPARATUS

391 reply
Bray

PP
10/29/03

REPLY BRIEF UNDER 37 C.F.R. 1.193 (b)

Assistant Commissioner for Patents
Washington, D.C. 20231

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OCT 28 2003

GROUP 3800

Sir:

Appellants reply to the Examiner's Answer dated August 15, 2003 as follows.

The appropriate interpretation of Talati et al is at issue in the present appeal. The Examiner's Answer does not distinguish between two clearly different disclosures of delivery that are explained in the reference. That is, Talati et al disclose delivery of transaction communication through an e-mail system and also separately disclose delivery of products to a client or purchaser through a regular mail system. However, the reference is mainly focussed on transaction authentication and validation processing that occurs before payment and delivery of an ordered product in

order to prevent fraudulent transactions from occurring over the Internet. The monitoring of delivery of products to a purchaser is not part of the system disclosed in Talati et al.

In particular, the object of Talati et al is to provide a system for electronic commerce among an originator (purchaser, user or client), a recipient (service provider or merchant) and a transaction administrator (TA), such as a Credit Authority (CA) or banking system (BS), as described at column 2, line 51 - column 3, line 3 of the reference. In this system, communications between the purchaser (originator 50) and credit authority CA (TA 60) or between the merchant (recipient 55) and the credit authority CA are established with a traceable delivery system such as an e-mail system (see col. 8, lines 21-25). A transaction request is validated based upon the purchasers' validation response and the accuracy of the information contained in the transaction request. If it is validated, the CA (TA) validates the transaction (step 120 in Fig. 4 and corresponding step in Fig. 6). Thereafter, the merchant and purchaser complete the transaction through unspecified "necessary processing" (see step 125 in Fig. 4, step 195 in Fig. 6 and step 230 in Fig. 8).

The processing necessary to complete the transaction after validation by the Talati et al system most likely includes delivery of the product that has been ordered by the purchaser and payment for the product. There is no disclosure, however, in Talati et al of managing trading in a manner equivalent to that in the present invention, which includes providing, creating or receiving the present status of processing initiated for an order, the present status of processing for delivery of the product corresponding to the order and providing a present status of processing for payment processing for the trading. Rather, the status of delivery is not mentioned as being part of the inventive system of Talati et al and the status of processing for payment is merely an indication of whether the bank accepts or rejects the transaction authorization and completes the payment transaction (see step 290 in Fig. 10).

The two different types of delivery that are mentioned without being distinguished in the Examiner's Answer are delivery of a product to a client by a merchant and delivery of communications through e-mail of the transaction validation and authorization communications associated with a transaction request or order for the product. That is, the delivery that

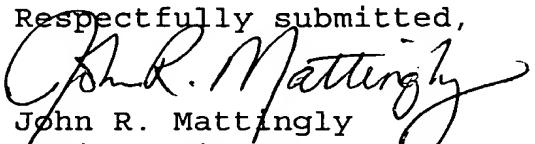
is mentioned in the reference with respect to a traceable delivery system (see col. 8, lines 17-25 of the reference) is not the delivery of a product that has been ordered in response to the input of a user. The delivery referred to in the context of a traceable delivery system is that of the electronic commerce transaction communication among the purchaser, merchant and credit authority, which is preferably performed by e-mail over the Internet.

Talati et al mention the delivery of an ordered product in the Description of Related Art section of the specification and nowhere else in the specification. The delivery of an ordered product is not part of the teachings of the inventive system of Talati et al. See col. 1, lines 56-66 of the reference, which mentions a delivery system such as "a regular mail system, telephone system, computer network or any other delivery system like UPS or Federal Express" can be used for delivery of a product between the client 10 and the merchant 20. In this cited portion of the Description of the Related Art in Talati et al, it is further mentioned that the "the delivery system between the client 10 and the merchant 20 must also have some tracking capability." However, such a tracking capability with respect to the delivery of a product is not

disclosed by Talati et al. Rather, Talati et al only disclose the tracking of e-mail in the delivery of communications among the purchaser, merchant and credit authority that occurs in conjunction with the validation of the transaction in order to prevent fraudulent transactions (see col. 2, lines 44-48 of the reference).

When the teachings of Talati et al are considered in proper context, one having ordinary skill in the art would not associate the descriptions of the inventive transaction validation and authorization system of Talati et al that uses an e-mail delivery system with the Background of the Invention discussion provided by Talati et al that sets forth a scant mention of all possible delivery systems that are available to deliver an ordered product to a purchaser. Talati et al disclose a system that is concerned with the transactions that occur before the order is provided to the client (note the last step of Fig. 8, step 230, which is to "Provide Order to Client"). Accordingly, a proper interpretation of Talati et al requires one having ordinary skill in the art to recognize that the reference does not disclose the receiving, transmitting or creating of trading processing information that is equivalent to that claimed in the present application.

Therefore, the decision of the Examiner rejecting claims 1-14 and 29-44 under 35 U.S.C. §103(a) should be reversed.

Respectfully submitted,

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on OCT 15 2003 by John Mattingly